

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

The specification and claims 10, 11, 13, 15, 20, 94, 95 and 96 have been amended in response to issues raised in the Office Action. New claim 104 finds support on page 242, lines 8-18 of the specification. The amendment to claim 15 finds support on page 292, lines 6-18 of the specification. Claims 1, 3-52, 65-88 and 91-104 are currently pending in this application. Claims 28-52 and 65-88 stand withdrawn from consideration on the merits.

Applicants acknowledge with appreciation the indication that claims 1, 3-10, 12, 14, 16-19, 21-27, 91-93, 96, 99 and 102 are allowed.

Turning to the Office Action, the specification was found objectionable for the reason given on pages 2-3 of the Action. In response, page 228 has been amended to correctly describe component (B8) as an organocarboxylic acid compound. Support for this change may be found, for example, on page 230, lines 13 and 19 of the specification. Claim 10 also was amended to provide the correct terminology. Accordingly, the objection to the specification and claim 10 has been obviated and should be withdrawn.

Claims 20, 94, 95, 100 and 103 were objected to for the reason set forth on page 3 of the Office Action. In response, claims 20 and 94-96 were amended to clarify that the silyl-containing copolymer rubber (A2) is prepared by reaction of an ethylene/ α -olefin/non-conjugated polyene random copolymer rubber which does not contain a silyl group with a silicon compound. The error is regretted and has now been corrected. Accordingly, this objection has been obviated and should be withdrawn.

Claims 13, 98 and 101 were rejected under 35 U.S.C. § 112, second paragraph, for the reason given on pages 3-4 of the Office Action. Reconsideration and withdrawal of this

rejection are requested in view of the above amendment to claim 13 and the following remarks.

Claim 13 no longer refers to a high molecular weight compound (K). Claim 13 now defines the copolymer rubber (A2) as in allowed claim 1, i.e. by a hydrosilylation reaction in the presence of a transition metal catalyst. Consequently, the § 112, second paragraph rejection is no longer applicable to claim 13 and should be withdrawn.

Claims 11 and 97 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,503,943 to Kresge et al. and teachings taken from "Organic Chemistry," pp 793-801, authored by Carey. The Examiner's rationale is given on page 4 of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

The rejection is based on the erroneous presumption that diisodecylphthalate (DIDP) disclosed in Kresge et al. '943 as an optional ingredient (column 3, line 11), is a hydrolysable ester (relying on "Organic Chemistry"). Phthalate esters such as DIDP are well-known as plasticizers. In fact, they are so identified on page 245 of the specification.

Plasticizers are required to be resistant to hydrolysis. Phthalate esters having a long chain alkyl group such as DIDP generally exhibit low reactivity to water. DIDP is not a hydrolysable compound and is not encompassed by the present disclosure or claims. Even if present in the claimed compositions, it would not be expected to produce the effects of the invention such as improved storage stability by dehydration.

Claim 11 now specifies that the composition includes a hydrolysable organosilicon compound (B10) other than the rubber (A1). Kresge et al. '943 does not disclose the addition of a compound (B10) in combination with the silane group-modified rubber. Nor does this reference disclose the compounds in new claim 104.

Accordingly, the § 102(b) rejection of claims 11 and 97 based on Kresge et al. '943 is inapplicable to the amended claims and should be withdrawn. Such action is earnestly requested.

Claims 13 and 101 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,503,943 to Kresge et al. for the reasons stated on pages 4-5 of the Office Action. Reconsideration of this rejection is requested in view of the above amendment to claim 13 and the reasons which follow.

Claim 13, as amended, now defines the rubber (A2) as in allowed claim 1, i.e. prepared by a hydrosilylation reaction in the presence of a transition metal compound. As such, claim 13 is patentable over Kresge et al. '943 and the § 102(b) rejection should be withdrawn.

Claim 13 was rejected under 35 U.S.C. § 102(b) as anticipated by JP 08-105227 to Iwasa et al. as set forth on page 5 of the Office Action. Since claim 13 now specifies that the copolymer rubber is prepared by hydrosilylation as in allowed claim 1, it is submitted that this rejection based on JP '227 is not applicable to amended claim 13 and should be withdrawn.

Claim 15 was rejected under 35 U.S.C. § 102(b) as anticipated by JP 08-105227 (Iwasa et al.) and EP 572 927 A1 to Hatanaka et al. for reasons given on page 5 of the Office Action. Withdrawal of this rejection is requested in view of the above amendment to claim 15 and the following.

Claim 15 defines the organic rubber (K2) by a Markush group of suitable materials. Butadiene/styrene copolymers are excluded from the Markush group. The references appear to only disclose butadiene/styrene elastomers. Accordingly, the § 102(b) rejection of claim 15 over JP '227 and EP '927 should be withdrawn.

Claims 11 and 13 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,028,483 to Bond et al. The Examiner's reasons are provided on pages 5-6 of the Office Action. Reconsideration of this rejection is requested in view of the aforementioned amendments and the reasons which follow.

Claim 11 now specifies that the hydrolysable organosilicon compound (B10) is other than the rubber (A1). Thus, the composition of claim 11 now includes a silyl group-containing rubber and an organosilicon compound other than the rubber. This feature is not disclosed in the reference.

Claim 13 now specifies that the rubber (A2) is produced by hydrosilylation as recited in allowed claim 1. This feature likewise is not disclosed in the reference.

Accordingly, the § 102(b) rejection of claims 11 and 13 based on Bond et al. '483 is no longer applicable and should be withdrawn. Such action is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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